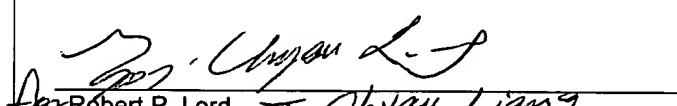




12-13-06

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<b>TRANSMITTAL OF APPEAL BRIEF</b>		Docket No. 03226/795001; SUN060205
In re Application of: Jonathan Casey Salas et al.		
Application No. 09/845,457-Conf. #3019	Filing Date April 30, 2001	Examiner M. A. Siddiqi
Invention: MANAGING USER ACCESS OF DISTRIBUTED RESOURCES ON APPLICATION SERVERS		
<b><u>TO THE COMMISSIONER OF PATENTS:</u></b>		
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>October 10, 2006</u> .		
The fee for filing this Appeal Brief is <u>\$ 500.00</u> .		
<input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity		
<input type="checkbox"/> A petition for extension of time is also enclosed.		
The fee for the extension of time is _____.		
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<input type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>50-0591</u> . This sheet is submitted in duplicate.		
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<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>50-0591</u> . This sheet is submitted in duplicate.		
 for Robert P. Lord    T. Chyan Liang Attorney Reg. No.: 46,479    48,885 OSHA · LIANG LLP 1221 McKinney St., Suite 2800 Houston, Texas 77010 (713) 228-8600		Dated: <u>December 11, 2006</u>
199590_1		



Docket No.: 03226/795001; SUN060205  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Jonathan Casey Salas et al.

Confirmation No.: 3019

Application No.: 09/845,457

Art Unit: 2154

Filed: April 30, 2001

Examiner: M. A. Siddiqi

For: MANAGING USER ACCESS OF  
DISTRIBUTED RESOURCES ON  
APPLICATION SERVERS

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANTS' BRIEF UNDER 37 C.F.R. § 41.37**

Dear Sir:

Pursuant to 37 C.F.R. § 41.37, please consider the following Appellants' Brief in the referenced Application currently before the Board of Patent Appeals and Interferences.

12/13/2006 BABRAHA1 00000046 09845457

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**I. Real Party In Interest**

The real party in interest for this appeal is Sun Microsystems, Inc. (“Sun”). An Assignment transferring all interest in the referenced application from the inventors to Sun was filed with the USPTO on March 2, 2006. The Assignment is recorded at Reel 017302, Frame 0814.

**II. Related Appeals, Interferences, And Judicial Proceedings**

To the best of the knowledge of the Appellants and the Appellants’ legal representative, there are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the decision of the Board of Patent Appeals and Interferences (“the Board”) in this appeal.

**III. Status of Claims**

Application Serial No. 09/845,457 (“the ‘457 Application”) was filed in April 30, 2001. As filed, the ‘457 Application included claims 1-19. In a response filed March 28, 2006, claims 1, 5-11, 14-17, and 19 were amended, claims 20-22 were added, and claims 2-4, 12-13, and 18 were cancelled. No additional claims have been subsequently cancelled or amended. Claims 1 and 11 are independent.

Claims 1, 5-11, 14-17, and 19-22 are currently pending in the ‘457 Application. All of the claims were finally rejected in a final Office Action dated July 7, 2006. A Notice of Appeal and Pre-Appeal Brief Request for Review were filed October 10, 2006. A Notice of Panel Decision from Pre-Appeal Brief Review was issued October 25, 2006, upholding the final rejection of claims 1, 5-11, 14-17, and 19-22.

**IV. Status of Amendments**

No claims have been amended or cancelled since the final Office Action dated July 7, 2006.

**V. Summary of Claimed Subject Matter**

Independent claim 1 relates to an apparatus. The apparatus includes: (i) a client coupled, via a network, to a plurality of resources, wherein said plurality of resources is located on an application server; and (ii) a system configured to control access to said plurality of resources, the system including: (a) a database configured to store a first license policy type, a second license policy type, a first policy instance, and a second policy instance, wherein the first policy instance is generated using the first license policy type and a first user specific parameter and the second policy instance is generated using the second policy type and a second user specific parameter, wherein the first user specific parameter and the second user specific parameter are associated with a same user; (b) a license manager configured to generate a token using the following steps: creating a first sub-token using the first policy instance; creating a second sub-token using the second policy instance; and combining the first sub-token and the second sub-token to generate the token, wherein the token enables the user to access one of said plurality of resources; and (c) a token monitor configured to initiate and terminate access to said one of said plurality of resources according to said token, wherein the token monitor is located on said application server. The apparatus recited in independent claim 1 is discussed in at least Figures 1-4, and pages 6-11 of the Specification.

Independent claim 11 relates to a method for managing access to a resource on a network. The method involves: (i) creating a first policy instance and a second policy instance, wherein the first policy instance is created using a first license policy type and a first user specific parameter and the second policy instance is created using a second policy type and a

second user specific parameter, wherein the first user specific parameter and the second user specific parameter are associated with a same user; (ii) verifying the first policy instance and the second policy instance by a license manager; and (iii) generating a token by said license manager, wherein the token enables the same user to access said resource, and wherein the token is generated by: (a) creating a first sub-token using the first policy instance, (b) creating a second sub-token using the second policy instance, and (c) combining the first sub-token and the second sub-token to generate the token. The method recited in claim 11 is discussed in at least Figures 2-3 and pages 8-11 of the Specification.

#### **VI. Grounds of Rejection to be Reviewed on Appeal**

The grounds of rejection to be reviewed on appeal are the rejection of claim 1 under 35 U.S.C. § 112 as being indefinite, and the rejection of claims 1, 5-11, 14-17, and 19-22 under 35 U.S.C. § 102(e) as being anticipated by Patel.

## VII. Argument

### A. Claim 1 is not indefinite under 35 U.S.C. § 112, second paragraph

In this appeal, the Appellant argues that claim 1 is not indefinite under 35 U.S.C. § 112, second paragraph, for at least the reasons given below.

The Examiner asserts that “a single claim which claims both an apparatus and the method of using the apparatus is indefinite under 35 U.S.C. § 112, second paragraph, because it is unclear which category of invention is being claimed.” Office Action dated July 7, 2006 at page 2. The Examiner cites *Ex Parte Lyell*, 17 U.S.P.Q 2d 1548 (BPAI 1990) in support of the rejection. *Lyell* states that “a single claim which claims both an apparatus and the method steps of *using the apparatus* is indefinite under 35 U.S.C. § 112, second paragraph.” See MPEP § 2173.05(p) (II). Applicants assert that *Lyell* is not applicable to claim 1.

Independent claim 1 recites, in part, “An apparatus, comprising … a client coupled … to a plurality of resources … and a system configured to control access to said plurality of resources, the system including … a database … *a license manager configured to generate a token using the following steps* … and a token monitor.”

The steps recited in claim 1 describe limitations of a single component (*i.e.*, the license manager) of the claimed apparatus. In contrast, the holding of *Lyell* is directed to the scenario in which a claim recites an apparatus and a method for *using the apparatus* and, thus, is not applicable to claim 1. Said another way, the holding in *Lyell* is only applicable to claims that recite an apparatus and a method, where the method describes the use of the apparatus *as a whole*. *Lyell* is not applicable to elements of an apparatus claim that recite steps as *limitations of a given component* of the apparatus. Thus, the Examiner has misconstrued and misapplied the holding of *Lyell* with respect to claim 1.

Accordingly, independent claim 1 is not indefinite under the second paragraph of 35 U.S.C. § 112.

**B. Claims 1, 5-11, 14-17, and 19-22 are not anticipated by Patel.**

In this appeal, the Appellant argues that claims 1, 5-11, 14-17, and 19-22 are not anticipated by Patel, for at least the reasons given below. For the purposes of this appeal, claims 1, 5-11, 14-17, and 19-22 stand or fall together. Claim 1 is representative of the group including claims 1, 5-11, 14-17, and 19-22.

Under 35 U.S.C. § 102(e), a claim in a patent application may be rejected if “the invention was described in (1) an application for patent, published under § 122(b), by another filed in the United States before the invention by the Appellant for patent....”

Furthermore:

Anticipation under 35 U.S.C. § 102 means lack of novelty, and is a question of fact. To anticipate, *every* element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.

*Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001) (emphasis added). The Federal Circuit has held repeatedly that anticipation requires disclosure of each and every element of the claimed invention in a single prior art reference. *See, e.g., Schering Corp. v. Geneva Pharms.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 (Fed. Cir. 1988); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1574 (Fed. Cir. 1986).

1. **Patel does not disclose creating separate sub-tokens and combining the separate sub-tokens to generate a token as recited in claim 1**

Independent claim 1 recites, in part,

a database configured to store a first license policy type, a second license policy type, a first policy instance, and a second policy instance, wherein *the first policy instance is generated using the first license policy type and*

*a first user specific parameter and the second policy instance is generated using the second policy type and a second user specific parameter, wherein the first user specific parameter and the second user specific parameter are associated with a same user;*

*a license manager configured to generate a token using the following steps: creating a first sub-token using the first policy instance; creating a second sub-token using the second policy instance; and combining the first sub-token and the second sub-token to generate the token, wherein the token enables the user to access one of said plurality of resources.*

Emphasis added. As recited in claim 1, two sub-tokens (*i.e.*, the first sub-token and the second sub-token) are created for the same user. Specifically, each of the sub-tokens is created using a policy instance (*i.e.*, a first policy instance and a second policy instance), where each of the policy instances is associated with the *same* user. Once the sub-tokens are created, the sub-tokens are combined to produce a token that allows the *same* user to access a resource.

The Examiner asserts that Patel discloses “creating a first sub-token using the first policy instance … creating a second sub-token using the second policy instance … and combining the first sub-token and the second sub-token to generate the token.” Office Action dated July 7, 2006 at page 4. The Examiner cites the same portions of Patel for *each* of the limitations of creating a first sub-token, creating a second sub-token, and combining the first sub-token and the second sub-token to generate the token. *See* Office Action dated July 7, 2006 at page 4. Specifically, the cited portion of Patel states:

Client License Manager 205 - This component requests licenses (“Access tokens”) from the License Server 106 when the client wants to run applications. The License Server 106 sends *an* “Access token” to the client that can be used to run the applications by presenting it to the Application Server 107. Along with the token, the License Server 106 also sends the *expiry time of the token*. The Client License Manager 205 renews the token just before the expiry period so that the client can continue running the application.

Patel, col. 10, lines 33-43. Patel clearly discloses issuing a *single* access token for a given user to access a resource. However, aside from disclosing that an access token is generated (if there is a valid license agreement) and that the access token includes an expiration time, Patel does not disclose *how* the access token is generated. *See* Patel, col. 8, l. 57 – col. 9, l. 1. In particular, Patel is completely silent with respect to generating a token using license policy types, policy instances, and sub-tokens as explicitly recited in claim 1. Further, Patel does not contemplate that the token allows the *same* user to access a resource. Therefore, the access token of Patel cannot be considered to be a token as recited in claim 1 unless the Examiner ignores express limitations of the claim and/or mischaracterizes the teachings of Patel.

Further, the Examiner is erroneously equating the “expiry time” disclosed in Patel to a sub-token. *See* Office Action mailed July 7, 2006 at pages 4-5. Claim 1 explicitly requires two sub-tokens to be *combined* to produce a single token. In contrast, the expiry time is merely a field associated with the single token disclosed in Patel. *See* Patel, col. 10, 33-52. No combination of any type is taught or contemplated. Therefore, the “expiry time,” as taught by Patel, cannot be considered to be a sub-token as recited in claim 1 unless the Examiner ignores express limitations of the claim and/or mischaracterizes the teachings of Patel. Accordingly, creating separate tokens and combining the separate tokens to generate a single token, as clearly recited in the claims, cannot be anticipated by Patel.

**2. Patel does not disclose initiation and termination of access to a resource according to the token**

Claim 1 recites, in part, “a token monitor configured to *initiate and terminate* access to said one of said plurality of resources according to said token.” Emphasis

added. The Examiner cites Patel, col. 9, lines 9-34 for disclosing this limitation of claim

1. See Office Action mailed July 7, 2006 at pages 4-5. As recited in Patel:

The Application Server 107 – Once the client 113 obtains an “Access token” to run an application, it connects to the Application Server 107 and presents to it the “Access token” along with the request for the application bits ... The Application Server 107 validates the “Access token” by ... making sure that the expiration time in the “Access token” has not elapsed.

Patel, col. 9, lines 9-22. This portion of Patel relied on by the Examiner only teaches gaining access to run an application based on the access token, provided that the access token has not expired. In other words, initiating access to a software application using the access token is explicitly disclosed and *denying* access to a software application if the access token has expired is implicitly disclosed in this portion of Patel.

Patel is completely silent with respect to *terminating* access to a resource according to a token. Instead, Patel discloses a client license manager that “renews the token just before the expiry period so that the client can continue running the application.” Patel, col. 10, lines 41-43. That is, once the client’s right to hold the license is established, the access token is created and used by the client to gain access to an application. In addition, the access token is renewed *prior to expiration* so that the application can *continue to be run* by the client. In other words, the access token is renewed so that the client’s access to the application *will not terminate* while the client is using the application. No mention is made of *terminating* the client’s access to the application based on the access token once access is initiated and the application is being used. Simply put, the recited claims explicitly require termination of access while Patel merely teaches denying access. Clearly, equating denying access (*i.e.*, saying “no,” but maintaining the connection) to terminating access (*i.e.*, cutting the connection

completely) is wholly improper and nonsensical to one skilled in the art. Accordingly, the "initiation and termination of access to said one of said plurality of resources according to a token" cannot be anticipated by Patel.

### C. Summary

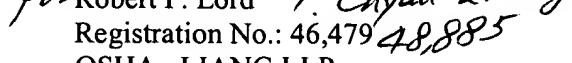
In view of the above, Patel clearly does not expressly or inherently describe *each and every* element of independent claim 1. Independent claim 11 includes substantially the same elements discussed above. Claims 5-10, 14-17, and 19-22 depend, directly or indirectly, from independent claims 1 and 11. Accordingly, Patel also does not expressly or inherently describe each and every element of claims 5-10, 14-17, and 19-22, for at least the same reasons.

## VIII. CONCLUSION

As discussed above, claim 1 is not indefinite under the second paragraph of 35 U.S.C. § 112. Furthermore, Patel does not anticipate claims 1, 5-11, 14-17, and 19-22 under 35 U.S.C. § 102(e). Accordingly, the Appellants respectfully request that the Board reverse the Examiner's rejections and allow claims 1, 5-11, 14-17, and 19-22 of the '457 Application.

Dated: December 11, 2006

Respectfully submitted,

By   
for   
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### Claims Appendix

1. (Previously Presented) An apparatus, comprising:
  - a client coupled, via a network, to a plurality of resources, wherein said plurality of resources is located on an application server; and
  - a system configured to control access to said plurality of resources, the system including:
    - a database configured to store a first license policy type, a second license policy type, a first policy instance, and a second policy instance, wherein the first policy instance is generated using the first license policy type and a first user specific parameter and the second policy instance is generated using the second license policy type and a second user specific parameter, wherein the first user specific parameter and the second user specific parameter are associated with a same user;
    - a license manager configured to generate a token using the following steps:
      - creating a first sub-token using the first policy instance;
      - creating a second sub-token using the second policy instance; and
      - combining the first sub-token and the second sub-token to generate the token,
    - wherein the token enables the user to access one of said plurality of resources; and
  - a token monitor configured to initiate and terminate access to said one of said plurality of resources according to said token, wherein the token monitor is located on said application server.
2. (Cancelled)

3. (Cancelled)
4. (Cancelled)
5. (Previously Presented) The apparatus of claim 1, wherein the token monitor comprises a criteria evaluator, wherein the criteria evaluator is configured to notify the token monitor when the first sub-token expires.
6. (Previously Presented) The apparatus of claim 5, wherein the criteria evaluator is configured to use a calendar to determine whether the first sub-token has expired.
7. (Previously Presented) The apparatus of claim 5, wherein the criteria evaluator is configured to use a counter to determine whether the first sub-token has expired.
8. (Previously Presented) The apparatus of claim 5, wherein the criteria evaluator is configured to use a timer to determine whether the first sub-token has expired.
9. (Previously Presented) The apparatus of claim 1, further comprising:  
a secondary access database configured to generate a third sub-token using a third policy instance, wherein the third sub-token is created after the first sub-token has expired and the third sub-token enables the same user to access said one of said plurality of resources.
10. (Previously Presented) The apparatus of claim 1, wherein a notification to create a new policy instance is sent to the client after the first sub-token has expired.
11. (Previously Presented) A method for managing access to a resource on a network comprising:

creating a first policy instance and a second policy instance, wherein the first policy instance is created using a first license policy type and a first user specific parameter and the second policy instance is created using a second policy type and a second user specific parameter, wherein the first user specific parameter and the second user specific parameter are associated with a same user;

verifying the first policy instance and the second policy instance by a license manager;

and

generating a token by said license manager,

wherein the token enables the same user to access said resource, and

wherein the token is generated by:

creating a first sub-token using the first policy instance,

creating a second sub-token using the second policy instance, and

combining the first sub-token and the second sub-token to generate the token.

12. (Cancelled)

13. (Cancelled)

14. (Previously Presented) The method of claim 11, further comprising:

creating a third sub-token using a third policy instance, wherein the third sub-token is created after the first sub-token has expired and the third sub-token enables the same user to access the resource.

15. (Previously Presented) The method of claim 11, wherein the license manager allows access to the resource for a period of time and the token only allows access to the resource for a portion of the period of time.

16. (Previously Presented) The method of claim 15, further comprising:  
generating a new token when the portion of the period of time expires and additional time from in the period of time remains.

17. (Previously Presented) The method of claim 11, further comprising:  
notifying the user when the first sub-token expires; and  
renewing, by the user, the first sub-token.

18. (Cancelled)

19. (Previously Presented) The method of claim 11, further comprising:  
monitoring the first sub-token by a token monitor associated with the resource; and  
terminating access to the resource when at least one selected from the group consisting of the first sub-token and the second sub-token expires.

20. (Previously Presented) The apparatus of claim 1, wherein the first policy type is one selected from the group consisting of by user, by usage, by client, by time, by date, and by resource.

21. (Previously Presented) The apparatus of claim 1, wherein the token monitor is further configured to attempt to renew the first sub-token after the first sub-token expires.

22. (Previously Presented) The method of claim 11, wherein the first policy type is one selected from the group consisting of by user, by usage, by client, by time, by date, and by resource.

**Evidence Appendix**

None.

**Related Proceedings Appendix**

None.



Application No. (if known): 09/845,457

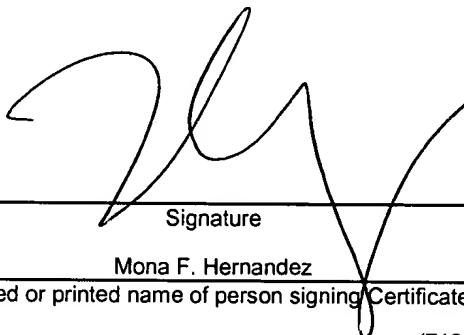
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